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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,768	06/06/2000	Shai Bar-Lavi	8039-1	8976
7590	12/08/2003		EXAMINER	
Frank Chau Esq F Chau & Associates LLP Suite 501 1900 Hempstead Turnpike East Meadow, NY 11554			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	6
DATE MAILED: 12/08/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

PQ

Office Action Summary	Application No.	Applicant(s)
	09/588,768	BAR-LAVI ET AL.
	Examiner David E. England	Art Unit 2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 - 26 is/are pending in the application.
- 4a) Of the above claim(s) 12-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 and 26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Claims 1 – 26 are presented for examination.

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 4 is acknowledged. The traversal is on the ground(s) that Both groups of claims are classified commonly in class 709 and that Applicant disagrees that Group II are drawn solely on application of database for multimedia. This is not found persuasive because Group II also having: downloading the communication module from a website provided by the server;
2. hyperlinking content provided by the server and by a sponsor;
3. profile inquiry pages along with other limitations and the utilization of a database shows that the two groups are distinct and are still restricted for these, and among other reasons.

The requirement is still deemed proper and is therefore made FINAL.

4. Claim 26 is directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claim 26, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, is now subject to being rejoined. Process claim 26 is hereby rejoined and fully examined for patentability under 37 CFR 1.104. In accordance with the Official Gazette notice, *supra*, process claims 12 – 25, which do not depend from or otherwise include all the limitations of the allowable product, are NOT been rejoined.

5. Claims 1 – 11 and 26 are now presented for examination.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term of "audiovisual" is not specifically described in the specification as to what it pertains to.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 recites the limitation "said audiovisual medium". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1 – 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (6047292) (hereinafter Kelly) in view of Berry et al. (6195693) (hereinafter Berry).

12. As per claim 1, as understood by the Examiner, Kelly teaches a method of communication between a server and a client, comprising the steps of:

13. embedding in a multimedia medium a communication module, said multimedia medium having a stored music program, (e.g. col. 5, line 42 – col. 6, line 7, “*data/application files*”);

14. distributing said audiovisual medium to the user, (e.g. col. 5, line 42 – col. 6, line 7, “*data/application files*”); and

15. installing in a computer the communication module, said communication module having stored codes executable by the computer to establish a communication link with a record and/or artist’s web page. Kelly does not specifically teach installing upon playback of the music program stored in the multimedia medium by the computer or a server. Berry teaches upon playback of the music program stored in the multimedia medium by the computer and a server, (e.g. col. 4, lines 15 – 32, “*response to playing*” & col. 2, line 52 – col. 3, line 20, “*server*”). It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Berry with Kelly because it would be more convenient for a system to simultaneously gather information about an artist while the user is listening to their favorite artist’s music. Furthermore, it is obvious and convenient for a record company utilize a server to store artist’s information and/or web sites so the artist’s numerous number fans could view information about the artist while having a server with the capabilities to support the amount of traffic numerous fans can accumulate.

16. As per claim 2, Kelly teaches said step of installing includes installation of a browser for facilitating communication between the record company’s web site and the user, (e.g. col. 1, lines 5 – 10 & col. 5, line 42 – col. 6, line 7, “*data/application files and web site*”), but does not specifically teach a server. Berry teaches a

server, (e.g. col. 2, line 52 – col. 3, line 20, “*server*”). It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Berry with Kelly because of similar reasons stated above.

17. As per claim 3, it is rejected for similar reasons as stated above. Furthermore, it is well known in the art that if a user is using a browser to view content on the web with a specific browser the server will communicate with the user on their computer system with the browser that is making requests

18. As per claim 4, Kelly teaches all that is disclosed above, furthermore, Berry teaches said communication link between the server and the user is via TCP/IP, (e.g. col. 2, line 52 – col. 3, line 20). It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Berry with Kelly because it would be more efficient for a system to utilize a common protocol, TCP/IP, to communicate on the Internet than to use a protocol that is not commonly utilized. Doing so would cause the packets of information to have more overhead which could add to the transmission time.

19. As per claim 11, Kelly teaches said multimedia medium is one of a compact disk (CD) and a DVD, (e.g. col. 5, line 42 – col. 6, line 7).

20. Claim 5 is rejected for similar reasons as stated above.

21. Claims 6, 7, 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (6047292) in view of Berry (6195693) and what is well known in the art.

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22. As per claim 6, Kelly teaches the use of specific OS such as Microsoft Windows, (Kelly, col. 3, line 55 – col. 4, line 5), but Kelly and Berry do not specifically teach said step of installing the communication modules includes installation of a linking icon displayed on one of a task bar tray and a desktop of the computer.

23. Examiner takes Official Notice (see MPEP § 2144.03) that "installation of a linking icon displayed on one of a task bar tray and a desktop of the computer" in a computer environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

24. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine what is well known in the art with the combine system of Kelly and Berry because it is well known in the art that if a program or file that is loaded to a computer with the Windows OS, as described in Kelly, that a user is on, the Windows OS can have an icon, shortcut, to the program or file that is installed on the user's computer.

25. As per claim 7, Kelly teaches the use of specific OS such as Microsoft Windows, (Kelly, col. 3, line 55 – col. 4, line 5), but Kelly and Berry do not specifically teach a pop-up window is displayed upon selection of said icon by the user.

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26. Examiner takes Official Notice (see MPEP § 2144.03) that " a pop-up window is displayed upon selection of said icon by the user" in a computer environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

27. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine what is well known in the art with the combine system of Kelly and Berry because it is well known in the art because it is well known in the art that on a Windows OS, as described by Kelly, when an icon is selected, doubled click, a type of window should appear as a result of selecting.

28. As per claim 9, Kelly teaches the communication module causes the computer to forward to the server data representing the usage of the window by the user, (e.g. col. 5, line 42 – col. 6, line 7).

29. Claim 26 is rejected for similar reasons as stated above.

30. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (6047292) in view of Berry (6195693) and what is well known in the art and in further view of Hosken (6438579).

31. As per claim 8, Kelly and Berry teach all that is disclosed above, but Kelly and Berry do not teach the communication module includes codes for causing the computer to monitor usage of the window by the user. Hosken teaches the communication module includes codes for causing the computer to monitor usage of the window by the user, (e.g. col. 3, lines 16 – 34). It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Hosken with the combine system of Kelly and Berry because it would give the system more functionality and interaction with the user and the server if information about the users viewing habits is stored so the server can compile a profile about the user and target specific subjects that the user might have interest in and present them to the user in a pleasing fashion.

32. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly (6047292) in view of Berry (6195693) and what is well known in the art and in further view of Govindarajan et al. (6208659) (hereinafter Govindarajan).

33. As per claim 10, Kelly and Berry teach all that is disclosed above, but Kelly and Berry do not teach the communication module includes codes for causing the icon to flash upon receipt of a message from the server. Govindarajan teaches the communication module includes codes for causing the icon to flash upon receipt of a message from the server, (e.g. col. 16, lines 55 – 67). It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Govindarajan with the combine system of Kelly and Berry because it would be more convenient for a system to alert the user of a message that could be of importance to the user at the time the massage arrives at the users system.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
35. Koyata et al. U.S. Patent No. 6622158 discloses Character information copying system, recording apparatus, and recording method.
36. Mages et al. U.S. Patent No. 5937164 discloses Method and apparatus of secure server control of local media via a trigger through a network for instant local access of encrypted data on local media within a platform independent networking system.
37. Van Zoest et al. U.S. Patent No. 6609105 discloses System and method for providing access to electronic works.
38. Leeke et al. U.S. Patent No. 6587127 discloses Content player method and server with user profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is none.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2143

De

DC



BUNJOB JABOENCHONWANIT
PRIMARY EXAMINER